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EXAMINER	
WASSUM, LUKE S	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/912,522	KIM ET AL.	
	Examiner	Art Unit	
	Luke S. Wassum	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Applicants' amendment, filed 3 April 2008, has been received, entered into the record, and considered.

2. As a result of the amendment, claim 3 has been amended. Claim 2 has been previously canceled. Claims 1 and 3-18 remain pending in the application.

The Invention

3. The Applicants' specification discloses a system for and method of analyzing and utilizing intellectual property.

Priority

4. The Applicants' claim to foreign priority under 35 U.S.C. § 119(a)-(d) based upon Korean patent application 2000-43108, filed 26 July 2000, is acknowledged. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 4-18 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

7. In light of the Applicants' remarks regarding the proper interpretation of the claimed 'units', page 8,

> Further, although the IP information extraction unit, the IP information analyzing unit, and the E-mail receiving/transmitting unit are described as separate units, these elements can be provided in a single unit, in which case these units could be implemented as software units.

claims 4 and 11 are rendered non-statutory under 35 U.S.C. § 101.

8. Regarding claims 4 and 11, these claims are for a system for analyzing and utilizing intellectual property (IP) information. However, all of the elements claimed could be reasonably interpreted in light of the disclosure by an ordinary artisan as being

software alone, and thus is directed to functional descriptive material [software *per se*], which is non-statutory. See *In re Warmerdam* (CAFC) 31 USPQ2d 1754 at 1759.

In order for software claims to be statutory, they must be claimed in combination with an appropriate medium and/or hardware to establish a statutory category of invention and enable any functionality to be realized. Compare *In re Lowry* (CAFC) 32 USPQ2d 1031 at 1031,1035 (claim to a data structure stored on a computer readable medium that increases computer efficiency held statutory) and *In re Warmerdam* (CAFC) 31 USPQ2d 1754 at 1759 (claim to computer having a specific data structure stored in memory held a statutory product-by-process claim) with *In re Warmerdam* (CAFC) 31 USPQ2d 1754 at 1760 (claim to a data structure per se held non-statutory).

Although the system is claimed as a *computer-based* system, the system is defined only by the claimed limitations. Since all claimed limitations are 'units', and since the Applicants have indicated that the proper interpretation of the claimed 'units' is that they can be implemented as software units, the claimed computer-based system is rendered software *per se*, and thus non-statutory.

9. Claims 5-10 and 12-18, fully incorporating the deficiencies of their respective parent claims, are likewise rejected.

Claim Rejections - 35 USC § 112

10. In view of the amendment to claim 3, the pending claim rejection under 35 U.S.C. § 112 is withdrawn.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Unger et al.** (U.S. Patent 5,721,910) in view of **Adler et al.** (U.S. Patent Application Publication 2003/0033295).

15. Regarding claim 1, **Unger et al.** teaches a method for analyzing and utilizing intellectual property (IP) information substantially as claimed, comprising steps of:

a) **registering search strategy formulas for extracting IP information** (see disclosure that a set of expert searches [search strategy formulas] can be

executed against a new set of patents and/or technical documents, col. 5, lines 64-66);

b) **accessing and searching Internet websites that provide IP information based on the registered search strategy formulas, and extracting first IP information according to the search** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2);

c) **converting the first IP information to a standard form and storing the first IP information, and transmitting the first IP information converted in the standard form to research center analyzing unit** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51);

d) **accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed**

information (see disclosure that specific detail on individual documents and/or abstracts and/or claims may also be captured in discrete fields and linked to the categories within the hierarchical model and the technical documents and/or abstracts and/or claims, and can be linked to full-text sources of the documents, col. 2, lines 40-46; the examiner further notes that the very existence of intellectual property information implies a project which produced said information, meaning that any IP information is related to a project);

e) **converting the second IP information to the standard form and storing the second IP information, and transmitting the second IP information converted in the standard form to research center analyzing unit** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51);

wherein the step (c) includes steps of:

i) **determining if third IP information has been received from the research center analyzing unit, the third IP information including technical analyses and opinion contents** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45); and

ii) **storing the third IP information upon receiving the third IP information** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45).

Unger et al. does not explicitly teach a method wherein the first IP information is discarded upon a determination by the research center analyzing unit that the first IP information is not related to at least one project accessible by the research center analyzing unit.

Adler et al., however, teaches a method wherein retrieved patent information is submitted to a relevancy filter, which deletes patent data which has been retrieved but

which is deemed not to be relevant to the analysis to be performed (see paragraph [0045] et seq.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to delete that retrieved patent information that is not deemed relevant, such as by not being pertinent to the project at hand, since this would advantageously allow users to minimize an amount of calculations to be carried out during the patent information assessment and minimize the amount of storage space required for storing the patent information (see paragraph [0045] et seq.).

16. Regarding claim 3, **Unger et al.** additionally teaches a method for analyzing and utilizing intellectual property (IP) information wherein step (d) includes steps of:

i) **determining if fourth IP information has been received from the research center analyzing unit, the fourth IP information including technical analyses and opinion contents** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45); and

ii) **storing the fourth IP information upon receiving the fourth IP information** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45).

17. Claims 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Unger et al.** (U.S. Patent 5,721,910) in view of **Adler et al.** (U.S. Patent Application Publication 2003/0033295) in view of **Walker et al.** (U.S. Patent 5,862,223).

18. Regarding claim 4, **Unger et al.** teaches a computer-based system for analyzing and utilizing intellectual property (IP) information substantially as claimed, comprising:

a) **an IP information extraction unit which is coupled to an IP information analyzing unit, for extracting IP information according to operation of software from at least one on-line IP information database (DB) found on the Internet or on a network and providing the extracted IP information to the IP information analyzing unit** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of

patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2; see also disclosure that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51);

b) **wherein the IP information analyzing unit controls the operation of the software, receives the extracted IP information and stores the same together with data containing opinion contents of the extracted IP information from research center analyzing unit, and outputs the extracted IP information** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45);

c) **wherein the research center analyzing unit is coupled to the IP information extraction unit and requests detailed information corresponding to the IP information that is related to the at least one project from the IP information extraction unit** (see disclosure that specific detail on individual documents and/or abstracts and/or claims may also be captured in discrete fields and linked to the categories within the hierarchical model and the technical documents and/or abstracts and/or claims, and can be linked to full-text sources of the documents, col. 2, lines 40-46; the examiner further notes that the very existence of intellectual property information implies a project which produced said information, meaning that any IP information is related to a project);

d) **wherein the IP information extraction unit comprises**:

i) **a front page extraction unit for requesting front pages of IP information according to a universal resource locator (URL) for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the front pages** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational

database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure at Stage III of drawing Figure 1 of front page information received and parsed into the database; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).

Unger et al. does not explicitly teach a system wherein the first IP information is discarded upon a determination by the research center analyzing unit that the first IP information is not related to at least one project accessible by the research center analyzing unit.

Adler et al., however, teaches a system wherein retrieved patent information is submitted to a relevancy filter, which deletes patent data which has been retrieved but which is deemed not to be relevant to the analysis to be performed (see paragraph [0045] et seq.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to delete that retrieved patent information that is not deemed relevant, such as by not being pertinent to the project at hand, since this would advantageously allow users to minimize an amount of calculations to be carried out during the patent information assessment and minimize the amount of storage space required for storing the patent information (see paragraph [0045] et seq.).

Neither **Unger et al.** nor **Adler et al.** explicitly teaches a system including an email receiving/transmitting unit, although the fact that it does disclose the accessing of patents and/or technical documents over the Internet provides strong evidence of obviousness for the inclusion of email capability.

Walker et al., however, teaches a system including **an email receiving/transmitting unit** (see col. 15, lines 21-42 et seq.), the Applicants' limitations of transmitting the extracted IP information and receiving opinion contents via email having been given no patentable weight as being merely a statement of intended use, although the reference also discloses the exchange of information between requester and an expert (see col. 18, lines 31-56; see also col. 26, lines 15-21).

It would have been obvious to include email capabilities in the system disclosed in the **Unger et al.** reference, since this would facilitate the exchange and accumulation of analysis and opinion information from experts without the necessity of having the experts all co-located at the central information facility.

19. Regarding claim 11, **Unger et al.** teaches a computer-based system for analyzing and utilizing intellectual property (IP) information substantially as claimed, comprising:

a) **an IP information extraction unit which is coupled to an IP information analyzing unit, for extracting IP information according to operation of software from at least one on-line IP information database (DB) found on the Internet or on a network and providing the extracted IP information to the IP information analyzing unit** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2; see also disclosure that the documents, etc., can be displayed on a

computerized graphical interface [research center personal computers], col. 3, lines 46-51);

b) **wherein the IP information analyzing unit for controls the operation of the software, provides technical classifications and search strategy formulas to the IP information extraction unit, receives the extracted IP information and stores the same together with data containing opinion contents of the extracted IP information from research center analyzing unit, and outputs the extracted IP information** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45);

c) **wherein the research center analyzing unit is coupled to the IP information extraction unit and requesting detailed information corresponding to the IP information that is related to the at least one project from the IP**

information extraction unit (see disclosure that specific detail on individual documents and/or abstracts and/or claims may also be captured in discrete fields and linked to the categories within the hierarchical model and the technical documents and/or abstracts and/or claims, and can be linked to full-text sources of the documents, col. 2, lines 40-46; the examiner further notes that the very existence of intellectual property information implies a project which produced said information, meaning that any IP information is related to a project).

Unger et al. does not explicitly teach a system wherein the first IP information is discarded upon a determination by the research center analyzing unit that the first IP information is not related to at least one project accessible by the research center analyzing unit.

Adler et al., however, teaches a system wherein retrieved patent information is submitted to a relevancy filter, which deletes patent data which has been retrieved but which is deemed not to be relevant to the analysis to be performed (see paragraph [0045] et seq.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to delete that retrieved patent information that is not deemed relevant, such as by not being pertinent to the project at hand, since this would advantageously allow users to minimize an amount of calculations to be carried out during the patent information assessment and minimize the amount of storage space required for storing the patent information (see paragraph [0045] et seq.).

Neither **Unger et al.** nor **Adler et al.** explicitly teaches a system including an email receiving/transmitting unit, although the fact that it does disclose the accessing of patents and/or technical documents over the Internet provides strong evidence of obviousness for the inclusion of email capability.

Walker et al., however, teaches a system including **an email receiving/transmitting unit** (see col. 15, lines 21-42 et seq.), the Applicants' limitations of transmitting IP information and receiving opinion contents via email having been given no patentable weight as being merely a statement of intended use, although the reference also discloses the exchange of information between requester and an expert (see col. 18, lines 31-56; see also col. 26, lines 15-21).

It would have been obvious to include email capabilities in the system disclosed in the **Unger et al.** reference, since this would facilitate the exchange and accumulation of analysis and opinion information from experts without the necessity of having the experts all co-located at the central information facility.

20. Regarding claim 5, **Unger et al.** additionally teaches a computer-based system wherein the IP information extraction unit further comprises:

a) **a data converter for converting front page data and outputting the same to the IP information analyzing unit** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure at Stage III of drawing Figure 1 of front page information received and parsed into the database; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).); and

b) **a specialized information extraction unit for requesting specialized IP information according to a URL for accessing the on-line information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the specialized IP information** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).

21. Regarding claims 6 and 13, **Unger et al.** additionally teaches a computer-based system wherein the IP information analyzing unit further comprises:

a) **a first DB for storing patent team opinion contents of at least one of front pages or specialized pages** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45);

b) **a second DB for storing research center opinion contents of at least one of front pages or specialized pages** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45);

c) **a quantitative analysis unit for outputting predetermined quantitative analysis graphs** (see drawing Figures 2 through 4);

d) **a management module for generating technical classifications and search strategy formulas for extracting IP information** (see disclosure that the database disaggregates a set of patents and/or technical documents into discrete technical categories by use of a set of pre-defined search protocols which match the scientific or technical concepts within the model, col. 3, lines 8-17); and

e) **a DB management unit for receiving the front pages or specialized pages from the IP information extraction unit and storing this information in the first DB, storing the research center opinion contents received from the research center analyzing unit in the second DB, and outputting signals for generating analysis graphs to the quantitative analysis unit** (see disclosure that the documents and/or abstracts and/or claims and/or

technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45).

22. Regarding claims 7 and 14, **Unger et al.** additionally teaches a computer-based system wherein **extraction periods of the IP information extraction unit are in real-time or programmed at predetermined intervals** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, and that this new set may represent recently published patents or technical documents, col. 5, line 64 through col. 6, line 1, explicitly disclosing the real-time extraction of IP information, and clearly suggesting extraction performed at predetermined intervals).

23. Regarding claims 8 and 15, **Unger et al.** additionally teaches a computer-based system wherein **the IP information extraction unit stores a plurality of predetermined keywords** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66).

24. Regarding claims 9 and 16, **Unger et al.** additionally teaches a computer-based system wherein **the IP information analyzing unit separates and displays analyzed data and data that have not been analyzed** (see disclosure that the system allows patents and/or technical documents to be electronically captured and analyzed at a convenient time, col. 6, lines 24-26).

25. Regarding claims 10 and 17, **Walker et al.** additionally teaches a computer-based system wherein **the email receiving/transmitting unit registers a plurality of predetermined email addresses according subject or field** (see disclosure of the expert database including email address and expert profile including subject area of expertise, col. 14, lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to maintain a list of email addresses according to subject or field, since this

would allow a user to submit a request to an expert having expertise in a subject field which corresponds to the request.

26. Regarding claim 12, **Unger et al.** additionally teaches a computer-based system wherein the IP information extraction unit further comprises:

a) **a front page extraction unit for requesting front pages of IP information according to a universal resource locator (URL) for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the front pages** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure at Stage III of drawing Figure 1 of front page information received and parsed into the database; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2);

b) **a data converter for converting front page data and outputting the same to the IP information analyzing unit** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure at Stage III of drawing Figure 1 of front page information received and parsed into the database; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).); and

c) **a specialized information extraction unit for requesting specialized IP information according to a URL for accessing the on-line information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the specialized IP information** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or

technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).

27. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Unger et al.** (U.S. Patent 5,721,910) in view of **Adler et al.** (U.S. Patent Application Publication 2003/0033295) in view of **Walker et al.** (U.S. Patent 5,862,223) as applied to claims 4-17 above, and further in view of **Ohtsuka** (U.S. Patent 6,088,765).

28. Regarding claim 18, **Unger et al.**, **Adler et al.** and **Walker et al.** teach a computer-based system for analyzing and utilizing intellectual property (IP) information substantially as claimed.

None of **Unger et al.**, **Adler et al.** nor **Walker et al.** explicitly teaches a computer-based system wherein the predetermined intervals are determined based upon the number of times a user connects to the computer-based system for analyzing and utilizing IP information.

Ohtsuka, however, teaches a system wherein stored information is periodically updated based upon the number of times a user connects to the system (see disclosure that address information is periodically updated in accordance with a frequency of access, col. 20, lines 33-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to update stored data based upon the frequency with which a user of the data accesses the system, since it would be a waste of system resources to update data at a much greater frequency than the frequency with which the user accesses the system; for instance, it might be wasteful to update data daily if the user accesses the system only monthly.

Response to Arguments

29. Applicant's arguments filed 3 April 2008 have been fully considered but they are not persuasive.

30. Regarding the Applicants' argument that the **Unger** reference fails to disclose or suggest the limitations of *transmitting the first IP information converted in the standard form*

to a research center analyzing unit; accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information; transmitting the second IP information converted in the standard form to the research center analyzing unit; and determining if third IP information including technical analyses and opinion content has been received from the research center analyzing unit, the examiner respectfully disagrees.

Each of these limitations has been addressed in the rejections of record, each with reference to specific portions of the **Unger** reference.

For instance, **Unger** teaches at col. 3, lines 46-51 that documents/abstracts/claims/technical indexing (the claimed first IP information) can be displayed on a computerized graphical interface (the claimed research center personal computers). [*transmitting the first IP information converted in the standard form to a research center analyzing unit*];

at col. 2, lines 40-46, that specific details on individual documents/abstracts/claims can be linked to full-text sources of the documents, and at col. 6, lines 48-53 that electronic full-text sources may be accessed on the Internet. [*accessing the Internet websites and extracting second IP information corresponding to the first IP information upon a request for detailed information*];

at col. 3, lines 46-51 that documents/abstracts/claims/technical indexing (the claimed first IP information) can be displayed on a computerized graphical interface (the claimed research center personal computers). [*transmitting the second IP information converted in the standard form to the research center analyzing unit*]; and

at col. 10, lines 40-48 and col. 11, lines 34-45, that a matrix of expert opinions representing the cumulative opinion of a group of expert technical staff and/or scientists is received and stored [*determining if third IP information including technical analyses and opinion content has been received from the research center analyzing unit*].

The Applicants' arguments amount to a mere allegation that the **Unger** reference fails to teach or suggest the above-cited limitations, but fails to offer any detailed explanation as to why the specifically cited portions of the reference fail to correspond to the claim limitations for which they are relied by the examiner in the rejection of record.

That being the case, the examiner maintains the rejections.

31. Regarding the Applicant's argument that the claimed system of claims 4 and 11 are statutory, the examiner respectfully disagrees.

For the reasons outlines in the rejection above, the claims are rendered non-statutory under 35 U.S.C. § 101. The issue of whether the claimed system (embodied in software) produces a useful, concrete and tangible result, as argued by the Applicants, is irrelevant unless the claimed software is first claimed in combination with an appropriate medium and/or hardware to establish a statutory category of invention and enable any functionality to be realized.

Since the claimed 'system' comprises software alone, without any medium and/or hardware, the claims are rendered non-statutory.

Conclusion

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119, or sent via email at luke.wassum@uspto.gov, **with a previous written authorization in accordance with the provisions of MPEP § 502.03.** Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Luke S. Wassum/
Primary Examiner
Art Unit 2167

lsw
30 June 2008